

Appl. No. 10/824,128
Docket No. 9210M
Amdt. dated November 5, 2007
Reply to Office Action mailed on August 3, 2007
Customer No. 27752

REMARKS

Claim Status

Claims 1-24 are pending in the present application. Claim 3 has been amended to correct a dependency issue. No additional claims fee is believed to be due.

Rejection Under 35 USC §112, Second Paragraph

Claims 3-4 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants did indeed intend to make Claim 3 dependent on Claim 2 where the thickeners and structure builders are introduced. As such, Applicants have amended Claim 3 to provide sufficient antecedent basis for the "thickeners and structure builders" limitation in line 1. Accordingly, Claims 3-4 are not indefinite. Reconsideration and withdraw of the Section 112 rejections are requested in view of the above discussion and amendments.

Rejection Under 35 USC §103(a) Over Drechsler in view of Morita

Claims 1-2 and 5-24 have been rejected under 35 USC §103(a) as being unpatentable over Drechsler *et al.* (US Patent 6,071,503) in view of Morita *et al.* (US Patent 6,500,439). Applicants respectfully traverse this rejection as the combined references do not teach or suggest all of the claim limitations, as required in MPEP 2143.03. Thus, the obviousness rejection given in the Office Action does not establish a *prima facie* case of obviousness.

Drechsler is directed to a transfer-resistant cosmetic composition, but neither the examples nor the specification of Drechsler teach the silicone modified fluorinated polymer of the present invention. The Office Action states that Drechsler does not disclose the use of a silicone modified fluorinated polymer. Applicants' independent claims - Claims 1, 17, and 22-24 - all require the presence of a silicone modified fluorinated polymer. Further, Drechsler does not disclose the use of thickeners. The Examiner interpreted the waxes disclosed as an optional component in Drechsler as

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thickeners. However, the present invention discloses both waxes and thickeners/structure builders. The thickeners/structure builders of the present invention are distinguishable from the waxes of Drechsler. Accordingly, Drechsler does not disclose the thickeners/structure builders of the present invention.

Morita is directed to a copolymer used in cosmetic compositions which includes a fluorine-containing (meth)acrylate and a silicone macromonomer. However, neither the examples nor the specification of Morita teach anhydrous mixtures of silicone modified fluorinated polymers, organosiloxane resins, and diorganopolysiloxane polymers in combination with a volatile carrier as disclosed and claimed in the present invention. The Office Action states that Morita discloses a fluorine modified copolymer to be used in a cosmetic composition. But, Morita actually teaches away from the use of such a copolymer as compared to the use of the silicone modified fluorinated polymer of the present invention:

The proportion of the fluorine-containing copolymer based on the total [fluorine-containing copolymer+ (water or solvent)] may be 1 to 60% by weight, preferably 10 to 40% by weight. The proportion less than 1% by weight leads to insufficient amount of the fluorine-containing copolymer content in the cosmetic and therefore sufficient water resistance and water- and oil-repellency cannot be exhibited. See Morita, col. 10, lines 17-27.

Conversely, the present invention uses silicone modified fluorinated polymers "at levels from about 0.01% to about 5%, preferably from about 0.1% to about 2.5% and most preferably from about 0.25% to about 1%" of the total amount of the cosmetic composition. See specification page 4, lines 25-27.

The Office Action also states that Morita discloses the use of thickeners in the cosmetic composition. Although Morita mentions the word "thickener," (col. 12, line 46) it does not teach or suggest the thickeners of the present application. It would not be within the knowledge of one having ordinary skill in the art to choose the thickeners/structure builders disclosed in the present invention, let alone the optimum percentages of said thickeners/structure builders. See specification page 7, lines 11-21.

The Examiner avers that while the references do not teach the combination and amounts of polymers to yield the desired viscosity of the composition, it would have been within the knowledge of one of ordinary skill in the art to select such a combination and

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amount. Additionally, the Examiner suggests that it would have been obvious to a person of ordinary skill in the art to incorporate the polymers of Morita and Drechsler into the complimentary product to achieve the desired effects of the polymers. Applicants respectfully submit however that there is no motivation or suggestion flowing from these references to do so.

Morita teaches against the use of fluorine modified copolymers in cosmetic compositions in the manner in which the present invention uses silicone modified fluorinated polymers. Thus, there is no motivation or suggestion to modify the Drechsler and Morita compositions to arrive at the claimed compositions. Nor would it have been obvious to a person of ordinary skill in the art to incorporate the polymers of Drechsler and Morita into the complementary product to achieve the desired effects of the polymers. The Supreme Court in its recent *KSR Int'l Co. v. Teleflex* decision stated the following:

Often, it will be necessary. . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. 127 S. Ct. 1727, 1740-41 (U.S. 2007) (emphasis added).

Thus, Applicants submit that recitation of the combination and amounts of polymers to yield the desired viscosity of the composition is novel and unobvious over the disclosures of Drechsler and Morita.

As evidenced above, Claims 1, 17, and 22-24 are patentably distinct from the applied references. Applicants respectfully contend that the Office Action does not establish a *prima facie* case of obviousness because the applied references, taken alone or in combination, fail to teach or suggest a composition as characterized in the independent claims. Thus, the applied references fail to render obvious Claims 1, 17, 22-24, and those claims depending therefrom. The Examiner is respectfully requested to reconsider and withdraw the rejection over the cited combination.

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Rejection Under 35 USC §103(a) Over Drechsler in view of Morita and Humbert

Claims 3-4 have been rejected under 35 USC §103(a) as being unpatentable over Drechsler *et al.* (US Patent 6,071,503) in view of Morita *et al.* (US Patent 6,500,439) and in further view of Humbert *et al.* (US Patent 4,137,302). Applicants respectfully traverse this rejection as the combined references do not teach or suggest all of the claim limitations, as required in MPEP 2143.03. Thus, the obviousness rejection given in the Office Action does not establish a *prima facie* case of obviousness.

Claims 3-4 ultimately depend from Claim 1. As discussed above, Drechsler, even when combined with Morita, fails to describe or teach the cosmetic composition of Claim 1 – much less the thickeners and structure builders of Claims 3-4. Since Humbert also does not disclose the cosmetic composition of Claim 1 comprising, *inter alia*, an anhydrous mixture of silicone modified fluorinated polymers and an organosiloxane resin in combination with a volatile carrier, Claims 3-4 are patentably distinct from the applied references. Accordingly, Applicants respectfully request the Office to reconsider and withdraw the rejection over the cited combination.

Conclusion

Applicants have made an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, Applicants respectfully request entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 
Signature

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Date: November 5, 2007
Customer No. 27752
(Amendment-Response to Office Action.doc)
Revised 11/17/2006

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